REMARKS

Claims 1-20 and 23-32 are all the claims pending in the application, and stand rejected on prior art grounds. Claims 1-20 and 23-32 stand rejected on the ground of non-statutory double patenting. Claims 2, 24, and 28-32 stand rejected upon informalities. Claims 1-20 and 23-27 stand rejected because the claimed invention is directed to non-statutory subject matter. Claims 1, 2, 23, 24, and 28-33 are amended herein. Applicants respectfully traverse these rejections based on the following discussion.

I. The Claim Objections

The Office Action indicates that the numbering of the claims is not in accordance with 37 C.F.R. §1.126, and more particularly, that claim 27 has been skipped. Accordingly, the Applicants have renumbered claims 28-32 as claims 27-31 to continue with the original numbering sequence. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this objection.

II. The Double Patenting Rejection

Claims 1-20 and 23-32 stand rejected on the ground of non-statutory double patenting over claims 1-16 of U.S. Patent No. 6,519,557 B1. These rejections are traversed as explained below. The Applicants have amended independent claims 1, 23, and 28, which are patentably distinct from U.S. Patent No. 6,519,557. In fact, U.S. Patent No. 6,519,557 does not teach or render obvious the same presently claimed invention as the Applicants' claimed language provides, "(means for) modeling all said documents as labeled tree representations; (means for)

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building a computerized dictionary of path representations relating to paths that occur in said documents; (means for) storing, for at least two said documents, said labeled tree representations of respective documents; (means for) storing, for said at least two said documents, said path representations relating to said paths that occur in said documents from root nodes to leaf nodes in said labeled tree representations of said respective documents; (means for) representing each of said documents in said document collection as an N-dimensional vector comprising an element i denoting a value of a feature associated with a particular path, wherein said feature comprises any of a presence or absence of said particular path in said documents and a frequency of occurrence of said particular path in said documents; (means for) calculating a measure of similarity between two of the documents based upon the frequency of occurrence of similar paths specified by the path representations; and (means for) using said measure of similarity to cluster a plurality of documents comprising similar information, wherein said documents comprise any of web page documents and eXtensible Markup Language (XML) documents, wherein two documents that differ only in the frequency of occurrence of the paths associated with said two documents are considered to be more similar to each other than two documents that differ in the occurrence of paths." Accordingly, the Applicants' claimed invention is patentable over U.S. Patent No. 6,519,557. Furthermore, the Applicants reserve the right to file a terminal disclaimer at a later time. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III.   The 35 U.S.C. §101 Rejection

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Claims 1-20 and 23-27 stand rejected under 35 U.S.C. §101 because according to the Office Action these claims lack patentable utility. However, the Applicants have amended independent claims 1, 23, and 28 to include, "(means for) using said measure of similarity to cluster a plurality of documents comprising similar information, wherein said documents comprise any of web page documents and eXtensible Markup Language (XML) documents." which clearly provides a useful, concrete, and tangible result. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. The 35 U.S.C. §112, Second Paragraph, Rejection

Claims 2, 24, and 28-32 stand rejected under 35 U.S.C. §112, second paragraph. Claims 29-31 have been amended to remove language pertaining to "said method". Claims 2, 24, and 29 have been amended to change "Document Model Object" to "Document Object Model". In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

V. The Prior Art Rejections

Claims 1-12, 14-20, and 23-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hattori et al. (U.S. Patent No. 6,889,223 B2), hereinafter referred to as "Hattori" in view of Cruz et al. "Measuring Structural Similarity Among Web Documents: Preliminary Results"; Cruz et al. 1998; Lecture Notes in Computer Science, Vol. 1375, page 513, hereinafter referred to as "Cruz". Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hattori, in view of Cruz, and in further view of Schuetze et al. (U.S. Patent

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No. 6,598,054 B2) hereinafter referred to as "Schuetze".

However, the claimed invention, as provided in amended independent claims 1, 23, and 28 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1, 23, and 28 generally recite, ""(means for) modeling all said documents as labeled tree representations; (means for) building a computerized dictionary of path representations relating to paths that occur in said documents; (means for) storing, for at least two said documents, said labeled tree representations of respective documents; (means for) storing, for said at least two said documents, said path representations relating to said paths that occur in said documents from root nodes to leaf nodes in said labeled tree representations of said respective documents; (means for) representing each of said documents in said document collection as an N-dimensional vector comprising an element i denoting a value of a feature associated with a particular path, wherein said feature comprises any of a presence or absence of said particular path in said documents and a frequency of occurrence of said particular path in said documents; (means for) calculating a measure of similarity between two of the documents based upon the frequency of occurrence of similar paths specified by the path representations; and (means for) using said measure of similarity to cluster a plurality of documents comprising similar information, wherein said documents comprise any of web page documents and eXtensible Markup Language (XML) documents, wherein two documents that differ only in the frequency of occurrence of the paths associated with said two documents are considered to be more similar to each other than two documents that differ in the occurrence of paths." Accordingly, the Applicants' claimed invention is patentable over the proposed combination of Hattori, Cruz, and Schuetze.

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Insofar as references may be combined to teach a particular invention, and the proposed combination of Hattori with Cruz, and Hattori with Cruz and Schuetze, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined. However, there is nothing in each of the references that suggests such a motivation to combine as suggested in the Office Action. In fact, had such a motivation been anticipated in any of the prior art references, then surely some discussion regarding alternative embodiments or manners of combination would have been suggested or at least inferred in any of the prior art references. In fact, no suggestion for combination is provided in any of the prior art references.

In In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination." There is nothing in the prior art that refers to a suggestion or desirability of making the proposed combination. Accordingly, the rejection under 35 U.S.C. §103(a) is prima facie defective.

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In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Appellants' novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Hattori, Cruz, and Schuetze, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as "representing each of said documents in said document collection as an N-dimensional vector comprising an element i denoting a value of a feature associated with a particular path, wherein said feature comprises any of a presence or absence of said particular path in said documents and a frequency of occurrence of said particular path in said documents; calculating a measure of similarity between two of the documents based upon the frequency of occurrence of similar paths specified by the path representations; and using said measure of similarity to cluster a plurality of documents comprising similar information, wherein said documents comprise any of web page documents and eXtensible Markup Language (XML) documents, wherein two documents that differ only in the frequency of occurrence of the paths associated with said two documents are considered to be more similar to each other than two documents that differ in the occurrence of paths." As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior

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art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Hattori fail to disclose all of the elements of the claims of the Applicants' claimed invention, but also, if combined with Cruz and Schuetze, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Hattori, alone, or in combination with Cruz and Schuetze teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." In view of the foregoing, the Applicants respectfully submit that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 23, and 28 and as such, claims 1, 23, and 28 are patentable over Hattori, alone, or in combination

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with Cruz and Schuetze. Further, dependent claims 2-20, 24-27, and 29-31 are similarly patentable over Hattori, alone, or in combination with Cruz and Schuetze, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.
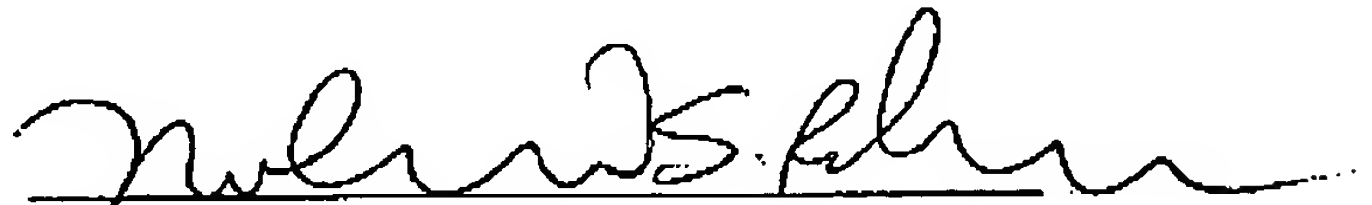
VI.   Formal Matters and Conclusion

With respect to the objections/rejections to the claims, the claims have been amended, above, to overcome these objections/rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objections/rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-20 and 23-32, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the
Examiner is requested to contact the undersigned at the local telephone number listed below to
discuss any other changes deemed necessary. Please charge any deficiencies and credit any
overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: May 30, 2006

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